

REMARKS

The non-final Office Action mailed November 9, 2010, has been carefully reviewed. From the summary page, claims 1-62 were pending and indicated as rejected. The Information Disclosure Statements filed July 28, 2010, and September 25, 2006, have been considered by the Examiner.

By this response, claims 1, 8, 13, 21, 26, 33, 35, 37, 38, 46 and 51 have been amended, and claims 12, 25, 37, 50 and 62 have been canceled. No statutory new matter has been added. Support for all claim amendments can be found in the originally filed disclosure.

In particular, independent claims 1, 13, 26, 38 and 51 have been amended to include certain features canceled from claims 12, 25, 37, 50 and 62, respectively. Claim 35 has been amended to correct dependency. Claims 8, 21, 33 and 46 have been amended to correct grammatical errors.

Claim Rejection under 35 U.S.C. 112, first paragraph

Claims 1-62 stand rejected as purportedly being non-enabling with respect to the features, “polymers” and “metal complex”. The rejection as to claims 12, 25, 37, 50 and 62 is moot upon cancellation. The rejection as to claims 1-11, 13-24, 26-36, 38-49 and 51-61 is respectfully traversed.

As an initial matter, the Examiner admits that the specification is enabling for the polymer species in claim 12. One of the polymers defined in claim 12 is a ketone-formaldehyde copolymer. A description of a ketone-formaldehyde copolymer is described at paragraphs [0023-24] of Applicants’ Publ. 2008/0255312. By this response, each of independent claims 1, 13, 26, 38 and 51 have been amended to define “*said one or more polymers including a ketone-formaldehyde copolymer*”. Therefore, the Examiner’s contention with respect to “polymers” has been overcome.

Next, the Examiner asserts that the “metal complex” is enabling for claim 2 but not reasonably enabled in the independent claim. Applicants submit that one of ordinary skill in the art would understand how to make the claimed invention in view of the description of a metal complex in the specification. Specifically, the specification describes the metal complex as preferably being a metal orthoester in addition to more preferable metal complexes. See, for example, para. [0020]. Hence, the claimed “metal complex” is enabled in light of the specification. Reconsideration of the Examiner’s position is requested by Applicants.

In view of the evidence submitted above, withdrawal of the rejection is kindly solicited.

Claim Rejection under 35 U.S.C. 112, second paragraph

Claims 1-62 stand rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The rejection as to claims 12, 25, 37, 50 and 62 is moot upon cancellation. The rejection as to claims 1-11, 13-24, 26-36, 38-49 and 51-61 is respectfully traversed.

The Examiner has requested clarification as to whether the phrase “*or combinations thereof*” is intended to refer to combinations of the antecedently recited polymers or to combinations of the antecedently recited groups. Applicants submit that the phrase “*or combinations thereof*” in each of claims 1, 13, 26, 38 and 51 refers to the combinations of antecedently recited groups. In view of this clarification, withdrawal of the rejection is kindly solicited.

Claim Rejections under 35 U.S.C. 102(b) and 103(a)

Claims 1-62 stand rejected as being purportedly anticipated by, or in the alternative, purportedly obvious over Japanese Document No. 10-067959 (hereinafter JP’959). Both rejections as to claims 12, 25, 37, 50 and 62 are moot upon cancellation. Both rejections as to claims 1-11, 13-24, 26-36, 38-49 and 51-61 are respectfully traversed.

JP’959 does not teach or suggest the features of “*one or more polymers having a terminal or pendant hydroxyl group, or a terminal or pendent carboxyl group, or combinations thereof, said one or more polymers including a ketone-formaldehyde copolymer*” as currently defined in independent claims 1, 13, 26, 38 and 51.

While JP’959 may disclose a printer ink including a polyamide resin and/or a cellulose derivative, or a polyurethane resin, as the hydroxyl group content resin, nowhere does JP’959 disclose a resin including a ketone-formaldehyde copolymer. See, for example, paras. [0015-16] of the English Machine Translation. Since each element of independent claims 1, 13, 26, 38 and 51 is not expressly taught by JP’959, the anticipation rejection must fail.

Independent claims 1, 13, 26, 38 and 51 also would not have been obvious in view of JP’959. Specifically, the claimed polymer or polymers as recited above are not taught or suggested by the resins described in JP’959. See, for example paras. [0015-16] of the English

Machine Translation. Hence, independent claims 1, 13, 26, 38 and 51 are patentably distinguishable over JP'959.

It is further submitted that each of independent claims 1, 13, 26, 38 and 51 recites a combination of “*said one or more polymers including a ketone-formaldehyde copolymer*” with “*at least one metal complex*” and “*at least one alkyl phosphate*” that exhibits improved adhesion and viscosity stabilization in inks and coatings. See, for example, Ink 3 (Experimental) in comparison with Inks 1, 2, 4 and 5 in Tables 3 and 4. Because JP'959 does not teach or disclose the claimed features mentioned above, the improved adhesion and viscosity stabilization resulting therefrom, as described in Tables 3 and 4, also would not have been suggested by JP'959. These results help further distinguish each of independent claims 1, 13, 26, 38 and 51 over the printer ink described in JP'959.

In view of the foregoing, withdrawal of both rejections as to independent claims 1, 13, 26, 38 and 51, and claims 2-11, 14-24, 27-36, 39-49 and 52-61 dependent thereon, is earnestly requested by Applicants.

CONCLUSION

The application is in condition for allowance and early, favorable action is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Dated: May 5, 2011

Respectfully submitted,

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